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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/461,090

12/14/1999

AXEL ULLRICH

2923-0347

3321

6449

7590

08/02/2006

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WASHINGTON, DC 20005

EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/461,090

Applicant(s)

ULLRICH ET AL.

Examiner

Frank W. Lu

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 39-48.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

ADVISORY ACTION

1. The proposed amendments filed on July 13, 2006 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

Response to Arguments

I. In page 6, second paragraph bridging to page 8, first paragraph of applicant's remarks, applicant argues: (1) "[I]n addition to the disclosure pointed out in applicant's last response, applicants respectfully point out original claim 1 which contains the language 'G protein mediated signal transduction'. Original claim 3 (which refers back to claim 1) refers to an 'extracellular signal pathway'. Thus, the current claim language is supported by a combination of originally filed claims 1 and 3. This wording is also supported by the disclosure on page 2, lines 7 to 10, where it is unambiguously disclosed that the growth factor receptor is activated via its extracellular domain and thus via an extracellular mechanism. It is shown on page 10, lines 25-32 that the GPCR ligand bound activation of the growth factor receptor does not comprise the intracellular domain"; and (2) in view of MPEP § 2163.02 and 2163.07, "[A]pplicants point out that that the exact language used in the claims does not need to appear in the specification".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. Although original claim 1 contains the language "G protein mediated signal transduction" and original claim 3 contains "an extracellular signal pathway", and page 2, lines 7-10 of the specification describes that activation of the growth-factor receptor is mediated by its extracellular domain and via an extracellular signal pathway, these description only supports that growth-factor receptor is mediated by its extracellular domain in G protein

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mediated signal transduction. Furthermore, although the examiner agrees that the exact language used in the claims does not need to appear in the specification, since the phrase “G protein mediated extracellular signal transduction pathway” is not limit to “growth-factor receptor is mediated by its extracellular domain in G protein mediated signal transduction” and is much broader than the disclosure in the specification as argued by applicant, the phrase “G protein mediated extracellular signal transduction pathway” is a new matter.

II. In page 8, last paragraph bridging to page 9, first paragraph of applicant’s remarks, applicant argues that the rejection under 35 U.S.C 102 on claims 39, 40, 42-45 and 47 should be withdrawn since “in the presently claimed method, the modulator binds directly to the growth factor receptor. In contrast to the present invention, Dong uses batimastat which inhibits the metallo-proteinase”.

This argument has been fully considered and is moot since the proposed amendments on claim 47 now require “contacting the cell with a compound which directly binds to a growth factor precursor”, which has not been found in claim 47 filed on November 28, 2005. The new amendments in claim 47 raise new issues that would require further consideration and/or search. Furthermore, since claims 39, 40, and 42-45 do not require “contacting the cell with a compound which directly binds to a growth factor precursor”, the rejection under 35 U.S.C 102 on claims 39, 40, and 42-45 are maintained.

III. In page 9, second paragraph bridging to page 10, first paragraph of applicant’s remarks, applicant argues that the rejections under 35 U.S.C 103 on claims 41, 46, and 48 should be withdrawn since either Miyoshi *et al.*, or Sherwood *et al.*, “does not cure the above discussed deficiencies in Dong”.

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection. First, as shown in above Response to Arguments, the argument related to claim 47 is moot since the proposed amendments on claim 47 now require "contacting the cell with a compound which directly binds to a growth factor precursor", which has not been found in claim 47 filed on November 28, 2005. The new amendments in claim 47 raise new issues that would require further consideration and/or search. Second, since, as shown in above Response to Arguments, the rejection under 35 U.S.C 102 on claims 39, 40, and 42-45 is proper, it is not necessary to use Miyoshi *et al.*, or Sherwood *et al.*, to cure the above discussed deficiencies in Dong as argued by applicant.


2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

July 26, 2006


FRANK LU
PRIMARY EXAMINER